



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,297	06/20/2001	Everett Lee Mitchell	3374-4-1-1	8096

22442 7590 06/22/2005

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
----------	--------------

3637

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/886,297	Applicant(s) MITCHELL, EVERETT LEE	
	Examiner Phi D. A	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-89 and 104-120 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 113, 114, 116, 117, 119 and 120 is/are allowed.
- 6) ☒ Claim(s) 56-64, 67-76, 79-87, 104-112, 115 and 118 is/are rejected.
- 7) ☒ Claim(s) 65, 66, 77, 78, 88 and 89 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/30/04</u> | 6) <input type="checkbox"/> Other: _____ |

Handwritten initials

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 56-60, 62-64, 67-72, 74-76, 79-83, 85-87, 104-112 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6298616. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims 56-60, 62-64, 67-72, 74-76, 79-83, 85-87, 104-112 are claimed and encompassed by the scope of the claims 1-10 of Patent 6298616.

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered new claims 112-119 have been renumbered 113-120.

Allowable Subject Matter

2. The indicated allowability of claims 75, 86 is withdrawn in view of the re-considered reference(s) to Ting (4840004). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 56, 58, 60-64, 67-68, 70, 72-76, 79, 81, 83-87, 104, 106-108, 110-112, 115, 118 are rejected under 35 U.S.C. 102(b) as being anticipated by Ting (4840004).

Ting (figure 2) shows a wall system having at least a first perimeter framing member (19), at least a second perimeter framing member (18, 46), the first and second perimeter framing members engage one another (through the seals 23), wherein at least one of the first and second perimeter framing members defining a recess extending inwardly relative to exterior surfaces of the first and second panels (17), at least one of the first and second perimeter framing members having a plurality of drainage holes (37), the plurality of drainage holes being in fluid communication with a gutter (28) located in an interior region behind the first and second panels and the first and second perimeter framing members, the gutter collects and provides to the drainage holes moisture located in the interior region for discharge into an exterior environment located exteriorly of the first and second framing members and first and second wall panels, a capillary break (the part on left and below holes 37) positioned on at least one of the framing

Art Unit: 3637

members, the break is spaced from the plurality of drainage holes and along with the surfaces of the recess defining a circulating chamber located interiorly of the capillary break (the area below and on the right side of the break, figure 2), whereby entry of terrestrial fluids into at least one of the plurality of holes is impeded, a free end of the break being separated from one of the first and second perimeter framing members by a gap through which the terrestrial fluids pass to enter the circulating chamber, a lower surface of the circulating chamber being contoured to permit terrestrial fluids collected in the circulating chamber in the form of a liquid to flow as a liquid through the gap along the lower surface (the surface on the right side of drainage holes 35) for discharge into the exterior environment, the plurality of drainage holes being located above the free end of the break, the capillary break extends downwardly from (does not have to touch the member from which it extends) the at least one of the first and second perimeter framing members, a first space between a free end of the capillary break and an opposing wall of the recess having a first vertical cross section area and a second spaced between opposing walls of a recess at a point between the break and the plurality of holes having a second vertical cross-sectional area and the second vertical cross sectional area is at least about 150% of the first vertical cross sectional area (the distance between the tip of the $\frac{1}{2}$ arrow and the opposing surface), at any location along the break, the centers of the plurality of drainage holes (37) lie along a common axis and wherein a distance of the holes above a free end of the break is at least about 125% of a distance from the free end of the break to an adjacent, opposing surface of the recess, a surface of the capillary break adjacent to the plurality of drainage holes being concave (figure 2, the surface located at the intersection of the flange of the break and the vertical part of the break), the plurality of drainage holes are spaced at regular intervals along the at least one of

Art Unit: 3637

the first and second framing members, a height of the break (30) ranges from about 125 to about 200% of a distance between a free end of the break and an adjacent, opposing surface of the recess, the holes(37) are located on one of the first and second members and the break (30) is located on the other of one of the members, the opening of the holes (37) being located on an at least substantially horizontal surface, the recess having a sloped lower surface (the surface to the left of 35) to permit terrestrial fluids in the chamber to flow along the surface and into the exterior environment, a surface of the break adjacent to the plurality of drainage holes being concave (the surface around holes 37) and the first and second wall panels being a composite of metal and plastic, at least most of the fluids pass along the lower surface through the gap and into the terrestrial environment, at least most the fluids do not pass through a gutter during the passing step, the break and the drainage holes being located on a common side of the chamber.

3. Claims 56, 61, 67, 69, 79, 104-112 are rejected under 35 U.S.C. 102(b) as being anticipated by Ting (5452552).

Ting (figure 2a) shows a wall system having at least a first perimeter framing member (21), at least a second perimeter framing member (15,23), the first and second perimeter framing members engage one another (through the seals 28), wherein at least one of the first and second perimeter framing members defining a recess extending inwardly relative to exterior surfaces of the first and second panels (74,71), at least one of the first and second perimeter framing members having a plurality of drainage holes (68,38), the plurality of drainage holes being in fluid communication with a gutter (39 and the area to the right) located in an interior region behind the first and second panels and the first and second perimeter framing members, the gutter collects and provides to the drainage holes moisture located in the interior region for

Art Unit: 3637

discharge into an exterior environment (27) located exteriorly of the first and second framing members and first and second wall panels, a capillary break (34) positioned on at least one of the framing members, the break is spaced from the plurality of drainage holes and along with the surfaces of the recess defining a circulating chamber (26, the space on the right side of part 34) located interiorly of the capillary break, whereby entry of terrestrial fluids into at least one of the plurality of holes is impeded, a free end of the capillary break being separated from one of the first and second perimeter framing members by a gap through terrestrial fluids pass to enter the circulating chamber, a lower surface of the chamber being contoured to permit fluids collected in the chamber in the form of a liquid to flow as a liquid through the gap along the lower surface for discharge into the exterior environment, the plurality of drainage holes being located above the free end of the break (34), the break extending downwardly from the at least one of the first and second perimeter framing members, the recess having a downwardly sloped lower surface (23) to permit terrestrial fluids in the chamber to flow along the lower surface and into the exterior environment, a surface of the break (24) adjacent to the drainage holes (38) is concave (form by the vertical and the lower curve flange) and wherein the first and second wall panels each is a composite of metal and plastic, the plurality of holes being located on the first perimeter framing member, the openings of the drainage holes being located on an at least substantially vertical surface (at 38) and the openings of the plurality of holes being located above a free end of the break (the free end of the flange at the middle of the break 15, 24), the break having a height and is separated by a gap from the first framing member and the height is at least about 100% of the width of the gap and the exterior surfaces of the first and second wall panels being at least substantially parallel and coplanar, the lower surface of the chamber being free of drainage holes,

Art Unit: 3637

at least most of the fluids pass along the lower surface through the gap and into the terrestrial environment, at least most the fluids do not pass through a gutter during the passing step, the break and the drainage holes being located on a common side of the chamber.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 57, 59, 69, 71, 80, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ting (5452552) or Ting (4840004).

Ting (...552) and Ting (.004) shows all the claimed limitations except for an adjacent edge of a nearest hole is at least about 0.75 inch from a rear surface of the break, an adjacent edge of a nearest drainage hole is at least about 0.25 inch from a rear surface of the break, and an adjacent edge of a nearest drainage hole being at least about 0.75 inch from the rear surface of the break.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ting (...552) or Ting (.004)'s structure to show an adjacent edge of a nearest hole is at least about 0.75 inch from a rear surface of the break, an adjacent edge of a nearest drainage hole is at least about 0.25 inch from a rear surface of the break, and an adjacent edge of a nearest drainage hole being at least about 0.75 inch from the rear surface of the break

Art Unit: 3637

because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

1. Claims 65-66, 77-78, 88-89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. The following is a statement of reasons for the indication of allowable subject matter: prior art does not show the drainage holes being above the free end of the capillary break, the break extending downwardly from the at least one of the first and second perimeter framing members, the openings of the drainage holes being located on an at least substantially vertical surface, the holes being located on one of the first and second perimeter framing members and the break being located on the other of the first and second perimeter framing members in combination with other claimed limitations.
3. Claims 113, 114, 116, 117, 119-120 are allowed.

Response to Arguments

4. Applicant's arguments with respect to claims 56-89, 104-120 have been considered but are moot in view of the new ground(s) of rejection.

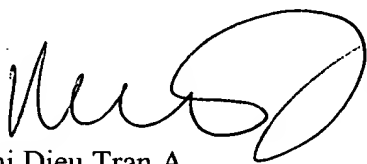
Art Unit: 3637

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 571-272-6864. The examiner can normally be reached on Monday-Tuesday, Thursday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large, stylized loop at the end.

Phi Dieu Tran A

6/15/05